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10/510,123	10/04/2004	Norman Understein	2802-34 (AMK)	6620
23117 7590 10/15/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
FERTIG, BRIAN E				
ART UNIT		PAPER NUMBER		
3694				
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10/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,123

Applicant(s)

UNDERSTEIN, NORMAN

Examiner

BRIAN FERTIG

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 11-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 7/14/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

3. Claims 1-9 and 11-17 are pending and examined below. Claim 10 is canceled.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites "means for" plus function language This

language invokes the rebuttable presumption that applicant seeks treatment under 35 U.S.C. 112, sixth paragraph. Such treatment requires that applicant clearly identify particular structures or steps within the disclosure as the means for or steps for that applicant intends to claim (see MPEP § 2181). No such clear identification has been found, rendering the claim indefinite. For the purposes of examination below, it is assumed that applicant did not intend to invoke treatment under 35 U.S.C. 112, sixth paragraph. Applicant is advised to explicitly rebut the presumption that 35 U.S.C. 112, sixth paragraph treatment has been invoked, amend the claims to remove the invoking language, or point out language in the disclosure that clearly identifies the particular structures or steps applicant intends to claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 6-9, and 11, and 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim recites a process directed to purely mental steps. The Office has taken the position before the Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130, that a statutory process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. The Office basis its position on Supreme Court precedent as recited in *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker V. Flook*, 437 U.S. 584,

588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70-71 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876). To qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

8. Applicant is also directed to MPEP § 2173.05p, providing guidance with respect to reciting a product and process in the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the effect of limitations within the preamble of a claim.

9. To the extent supported by Applicant's disclosure, Examiner respectfully suggests performing one or more of the step 'electronically' or positively reciting that a computer system performs one or more of the steps. (i.e. the depository administrator electronically processing the funds . . . or a depository administrator computer system processing the funds . . .). Note that this suggestion is provided for the purposes of example only and is not meant to convey allowable subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0026396 for Dent (Dent) in view of US Patent Application Publication 2001/0034676 for Vasic (Vasic).

With respect to claim 1

Dent teaches:

A method of processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the method comprising:

(a) the transferor accessing the depository administrator via a global network (see par 40);

(b) the transferor requesting a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee (see par 44, note that payment can be initiated, requested and approved to fellow users);

(c) if the transferee does not have a transferee deposit sub-account administered via the depository administrator, providing the transferee an opportunity to establish the transferee deposit sub-account (see par 45, note that non-users are invited to join); and

(d) the depository administrator processing the funds between the transferor deposit sub-account and the transferee deposit sub-account

(see par 66, note that the transaction is posted to the payee's FSC account),

Dent does not explicitly teach:

- the sub-account features
- wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account.

Vasic teaches:

- the sub-account features (see par 56)
- wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account (see par 56, note that the structure taught by Vasic fairly suggests a lack of affect on the mater account under either of at least two interpretations. First, once the sub-account is funded by a transfer of funds from the mater account, any transfer of funds between the accounts would have no impact on the master account since the funds are transferred between sub-accounts. Second, the relationship of master account to sub-account fairly suggests that the sum of the balances in the sub-account are attributable to the overall balance of the master account. As such, any transfer between sub-accounts would leave the balance in the master account unchanged).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have provided Dent with the sub-account featured of Vasic in order to have maintained funds in the master account until the access to a sub-account has been requested by the employee as taught explicitly by Vasic, see par 56. Note that Applicant admits that the use of sub-account management systems are used by Financial Institutions (see Specification, pg 2, lines 8-11).

With respect to claim 2

Dent in view of Vasic teaches:

A method according to claim 1 (see rejection fo claim 1 above), wherein step (b) further comprises enabling the transferor to input an E-mail address of the transferee (see Dent par 106-107), and wherein the method further comprises alerting the transferee via E-mail that the transfer or hold of funds has been requested (see Dent par 105-107).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 3

Dent in view of Vasic teaches:

A method according to claim 2 (see rejection of claim 2 above), wherein step (c) is practiced by the depository administrator comparing the transferee E-mail address with stored E-mail addresses of deposit sub-account holders to thereby determine whether the transferee has an existing transferee deposit sub-account (see Dent par 92-93 in combination with Dent par 99-101, note that a user is invited to enter their email address as their user_ID, note that a payer selects the

user_ID in the course of initiating a payment, and the FTM determines whether the payee is an FTM user, thus fairly suggesting the claimed determination in so far as a selection of an email address by the payor from the list enables the FTM to determine whether the payee is an FSC user).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 4

Dent in view of Vasic teaches:

A method according to claim 3 (see rejection of claim 3 above), wherein if the transferee does not have a transferee deposit sub-account administered via the depository administrator, the step of alerting the transferee via E-mail further comprises providing a link to the depository administrator enabling the transferee to establish the transferee deposit sub-account (see Dent par 108-109 and fig 13).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 5

Dent in view of Vasic teaches:

A method according to claim 3 (see rejection of claim 3 above), wherein if the transferee has a transferee deposit sub-account administered via the depository administrator, the step of alerting the transferee via E-mail further comprises providing a link to the transferee deposit sub-account (Dent in view of Vasic does not explicitly teach sending an email to a transferee with a sub-account, however, it would have been obvious to one having ordinary skill in the art at the time of

Applicant's invention to have duplicated the email communication to non-FSC user feature for current FSC users in order to have alerted them to the transaction and provided a link to easily access the system as taught implicitly by Dent, see par 108-109 and fig 13, since the email informs the user of the transaction and provides a link by which to easily access the FSC system).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 6

Dent in view of Vasic teaches:

A method according to claim 1 (see rejection of claim 1 above), wherein step (d) is practiced by holding the funds in the transferor deposit sub-account until receiving confirmation that an event has occurred (see Dent par 123, note the authorization feature).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 7

Dent in view of Vasic teaches:

A method according to claim 6 (see rejection of claim 6 above), wherein the confirmation that an event has occurred comprises confirmation by the transferor (see Dent par 123, note the authorization feature).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 8

Dent in view of Vasic teaches:

A method according to claim 6, wherein the confirmation that an event has occurred comprises confirmation of product delivery (see Dent par 123, note that the Authorization function, coupled with the dispute button fairly suggests that the authorization is meant to convey agreement on the part of the payor of the efficacy of the bill. Further Bills are presented for products or services. Applicant's disclosure has failed to identify any particular utility to the confirmation of a product and, in fact, implies that either are confirmation of a product or service are variants when reading claims 8 in vie of 9. As such, the fact that the event is the confirmation of a product deliver is considered to be an obvious design choice and not afforded patentable weight so as to distinguish Applicant's invention over the prior art.).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 9

Dent in view of Vasic teaches:

A method according to claim 6 (see rejection of claim 6 above), wherein the confirmation that an event has occurred comprises confirmation of service completion (see Dent par 123, note that the Authorization function, coupled with the dispute button fairly suggests that the authorization is meant to convey agreement on the part of the payor of the efficacy of the bill. Further Bills are presented for products or services. Applicant's disclosure has failed to identify any particular utility to the confirmation of a service and, in fact, implies that either are confirmation of a product or service are variants when reading claims 8

in view of 9. As such, the fact that the event is the confirmation of a service deliver is considered to be an obvious design choice and not afforded patentable weight so as to distinguish Applicant's invention over the prior art.).

(See rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 11

Dent in view of Vasic teaches:

A method according to claim 1 (see rejection of claim 1 above), further comprising issuing automated teller machine (ATM) cards to holders of deposit sub-accounts, and enabling the transferor and transferee to deposit funds or withdraw available funds via their respective ATM cards (See Vasic, par 56-57).

It would have been further obvious to one having ordinary skill in the art at the time of Applicant's invention to have provided Dent with the ATM features of Vasic in order to have allowed a user to transfer funds linked to the ATM card as taught explicitly by Vasic (see par 57).

With respect to claim 12

Dent in view of Vasic teaches:

A method according to claim 11 (see rejection of claim 11 above), further comprising, prior to step (a), the transferor depositing funds into the transferor deposit sub-account using the transferor's ATM card, and after step (d), the transferee withdrawing funds from the transferee deposit sub-account via the transferee's ATM card (see Dent par 101 in combination with Vasic, par 56-57).
Note that Dent's teaching of determining that adequate funds are available

implies that funds have been transferred into the account. Vasic's teaching of transferring funds via ATM fairly suggests deposit and withdrawal of funds using an ATM)

(See rationale supporting obviousness and motivation to combine of claims 1 and 11 above)

With respect to claim 13

Dent in view of Vasic teaches:

A method according to claim 11 (see rejection of claim 11 above), further comprising, after step (d), the transferee withdrawing funds from the transferee deposit sub-account via the transferee's ATM card (see Vasic par 56-57).

(See rationale supporting obviousness and motivation to combine of claims 1 and 11 above)

With respect to claim 14

Dent in view of Vasic teaches:

A method according to claim 1 (see rejection of claim 1 above), wherein the depository is a bank (see Dent par 14, note that the accounts may be traditional bank accounts. Note that the teaching of the 'proxy' functionality fairly suggests the equivalence of the financial accounts and bank accounts).

(See rationale supporting obviousness and motivation to combine of claims 1 above)

With respect to claim 15

Dent in view of Vasic teaches:

A method according to claim 1 (see rejection of claim 1 above), wherein the depository is a retail establishment (see Dent par 11, note that the system is directed to facilitating personal electronic financial transaction, fairly suggesting that the services are made available to individuals, thus fairly suggesting a retail establishment).

(See rationale supporting obviousness and motivation to combine of claims 1 above)

With respect to claim 16

Dent in view of Vasic teaches:

A computer system for processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the computer system comprising:

at least one user computer running a computer program that enables the transferor to access the depository administrator to request a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee (see Dent par 42); and

a system server running a server program (see Dent 52-56), the at least one user computer and the system server being interconnected by a computer network (see Dent par 40), the system server processing the funds between the transferor deposit sub-account and the transferee deposit sub-account (see Dent par 66, note that the transaction is posted to the payee's FSC account), wherein if the transferee does not have a

transferee deposit sub-account administered via the depository administrator, the system server providing the transferee an opportunity to establish the transferee deposit sub-account (see Dent par 45, note that non-users are invited to join), wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account (see Vasic par 56, note that the structure taught by Vasic fairly suggests a lack of affect on the mater account under either of at least two interpretations. First, once the sub-account is funded by a transfer of funds from the mater account, any transfer of funds between the accounts would have no impact on the master account since the funds are transferred between sub-accounts. Second, the relationship of master account to sub-account fairly suggests that the sum of the balances in the sub-account are attributable to the overall balance of the master account. As such, any transfer between sub-accounts would leave the balance in the master account unchanged).

(See rationale supporting obviousness and motivation to combine of claims 1 above)

With respect to claim 17

Dent in view of Vasic teaches:

A computer program embodied on a computer-readable medium for processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the

depository administrator maintaining a master account at a financial institution, the computer program comprising:

means for the transferor to access the depository administrator via a global network (see Dent par 42);

means for the transferor to request a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee (see par 44, note that payment can be initiated, requested and approved to fellow users);

if the transferee does not have a transferee deposit sub-account administered via the depository administrator, means for providing the transferee an opportunity to establish the transferee deposit sub-account (see Dent par 45, note that non-users are invited to join); and

means for the depository administrator to process the funds between the transferor deposit sub-account and the transferee deposit sub-account (see Dent par 66, note that the transaction is posted to the payee's FSC account), wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account (see Vasic par 56, note that the structure taught by Vasic fairly suggests a lack of affect on the mater account under either of at least two interpretations. First, once the sub-account is funded by a transfer of funds from the mater account, any transfer of funds between the accounts would have no impact on the

master account since the funds are transferred between sub-accounts.

Second, the relationship of master account to sub-account fairly suggests that the sum of the balances in the sub-account are attributable to the overall balance of the master account. As such, any transfer between sub-accounts would leave the balance in the master account unchanged).

(See rationale supporting obviousness and motivation to combine of claims 1 above)

Response to Arguments

12. Applicant's arguments with respect to claim 1-9, and 11-17 have been considered but are moot in view of the new ground(s) of rejection.

Inquiry

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694